UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,065	08/26/2003	Jeffrey M. Alaimo	101990025005	2935

7590 06/02/2005

Mitchell Rose, Ph.D., Patent Agent
JONES DAY
North Point
901 Lakeside Avenue
Cleveland, OH 44114

EXAMINER	
STASHICK, ANTHONY D	

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/648,065	ALAIMO ET AL.	
	Examiner	Art Unit	
	Anthony Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16,29-31 and 35-54* is/are pending in the application.

4a) Of the above claim(s) *52-54* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16 and 29-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *08262003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 52-54 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims include a package and details directed to the package which were not previously claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 52-54 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Marshall 6,042,759. Marshall '759 discloses all the limitations of the claims including the following: stocking a predetermined number of sets of foot orthotics (see col. 10, lines 35-42); each set having a standard arch height that is unique for that set (see col. 10, line 45-col. 11, line 30); measuring an arch height of a sole of a foot (see col. 11, lines 18-30); selecting an orthotic from the set for which the standard height most closely matches the measured height (see col. 11, lines 31-48); the predetermined number equals three (see col. 10, lines 35-42); the measuring step

includes determining the arch height from a footprint of the sole (see col. 11, lines 18-31); the orthotics can be heat-softened (made of material that can be heat-softened, col. 8, lines 31-32); pressing the sole of the user's foot against the selected orthotic while the selected orthotic is installed in a shoe in a heat-formed state (orthotic heated by user's foot).

4. Claims 6-9, 13-16 and 35-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Dribbon 5,678,566. Dribbon '566 discloses all the limitations of the claims including the following: engaging the sole of a foot against a thermal imaging device 12 that yields a thermal image of the sole; determining a characteristic of the sole based on the thermal image (see col. 4, lines 36-43); the characteristic is an arch height of the sole (based on color change, height can be determined); the imaging device includes a thermally sensitive material that exhibits a change in color with a change in temperature (see col. 4, line 58-col. 5, line 2); the thermally sensitive material is liquid-crystal-based (see col. 4, lines 7-12); the imaging device is in the form of a plate (see Figures 2 and 3) configured to lie flat on the ground and the engaging step includes stepping on the device; the imaging device yields a thermal image of the sole based on the difference in temperature between the sole and the device (see col. 4, line 58- col. 5, line 11); the thermal image indicates pressure points of the sole (see col. 5, lines 12-40); the thermal image indicates restricted blood flow locations of the sole (see col. 5, lines 24-27).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 10-12 and 43-47 are rejected under 35 U.S.C. 103(a) as being obvious over Dribbon 5,678,566 as applied to claim 8 above. Dribbon '566 as applied to claim 8 above discloses all the limitations of the claims except for the temperature of the foot and thermally sensitive material. Dribbon '566 teaches that the foot can be bare and placed on the ground prior to installation into the footwear onto the thermally sensitive material. Dribbon '566 also teaches that the foot of the user can be taken from the user's shoe and placed upon the thermally sensitive material, thereby meeting the requirement that the foot be heated or warmer than the thermally sensitive material. Therefore, since the thermally sensitive material's operation is based upon the temperature difference between the material and that which is placed upon the material, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to heat of cool the user's foot to get a higher contrast in temperature between the user's foot and the thermally sensitive material to get a better change in color to better show or enhance the problems associated with the user's foot.

7. Claims 3, 4, 29-31 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 6,042,759 as applied to claim 1 above in view of Dribbon 5,678,566. Marshall '759 as applied to claim 1 above discloses all the limitations of substantially as claimed except for the thermal imaging device and the exact number of 3 sets. Marshall '759 teaches one of ordinary skill in the art that many sets of orthotics can be stored and it is well within the skill of one of ordinary skill in the art to make the number in each set necessary the smallest possible for the right combinations, including only 3 orthotics per set. Dribbon '566 teaches that a thermal imaging device can be used on the floor or in a shoe to pattern the bottom plantar surface of a

user's foot to aid in determining problems with the user's foot. Dribbon '566 further teaches that he thermal imaging device exhibits a change in color in response to the different temperatures and pressures of the user's foot while the user is standing on the thermal imaging device. Furthermore, Dribbon '566 teaches the warming of the user's foot (i.e. from placing the user's foot from within their shoe onto the thermal imaging device) to obtain a thermal image of the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a thermal imaging insole on the orthotic of Marshall '759 to aid in determining the pressures and heights of the different portions of the user's plantar surface. With respect to the use of a rack and the positioning of the imaging device in front of the rack, it is well known in the art of selling shoes and orthotics, to place the stock on racks or the ground to stock the inventory.

Response to Arguments

5. Applicant's arguments filed March 7, 2005 have been fully considered but they are not persuasive. Applicant argues that Marshall does not disclose stocking orthotics. This argument is not clearly understood. Marshall clearly discusses stocking groups of molded orthotics and selecting an orthotic to correct to the user's foot. With respect to the argument that Marshall discloses a number greater than three, this argument is addressed in the rejections set forth above. With respect to applicant's argument that claim 6 requires that the orthotic be located outside of a shoe, this argument is not clearly understood. Since the orthotic of Marshall is removable, one of ordinary skill in the art would deduce that the thermal orthotic would be used against the user's foot whether inside a shoe or outside the shoe. With respect to the arguments

that Dribbon does not disclose determining the arch height, this argument is not clear. Dribbon teaches that a thermographic reading of the top surface of the insole is achieved. One of ordinary skill in the art would recognized that the further away from the user's foot, the cooler reading and therefore determine the arch height by the change in color in that area.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Stashick
Primary Examiner
Art Unit 3728

ADS